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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,082	06/24/2004	Shuichi Kitamura	542-012.010	5847

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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,082

Applicant(s)

KITAMURA ET AL.

Examiner

Michael Bernshteyn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on July 10, 2006. Applicants have amended claim 1, claims 2 and 12 have been cancelled
2. In view of the amendment and Declaration under 37 CFR 1.132, the rejection of claims 1-6 and 8-19 under 35 U.S.C. § 102(b) and the rejection of claim 7 under 35 U.S.C. § 103(a) have been withdrawn.
3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.
4. Claims 1, 3-11 and 13-19 are pending.

Claim Rejections - 35 USC § 102

5. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

6. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
7. Claims 1, 3-6 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishiguchi et al. (JP 09-324096).

With regard to the limitations of claims 1, 3-6 and 11, Nishiguchi discloses a composition comprises a modified PVA resin having anionic groups (preferably carboxyl

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and/or sulfo groups) preferably in the amount of 2.0-40.0-mol% and a PVA resin having a degree of saponification of 70-99% and a degree of polymerization 200-8,000. The modified PVA resin having carboxylic groups is produced by Michael addition reaction with acrylonitrile or acrylamide and partly or fully hydrolyzing the reaction product, wherein the weight ratio of A:B is from 95:5 to 5:95, which is within the claimed range (abstract). Example 1 discloses a film formed from a composition comprising a mixture of 35 parts of a modified PVA having saponification degree of 96.3%, and 65 parts of a modified PVA having saponification degree of 71.1%. This film has mechanical strength, alkali-resistance, hygroscopy and crack resistance and has dissolution rate; it is suitable to encapsulate chemical products, (Table 1, page 4, [0038]-[0040]).

With regard to a ratio of storage modulus and a glass temperature instantly claimed in claim 1, Nishiguchi is silent about it. However, in view of substantially identical polyvinyl alcohol composition between Nishiguchi and instant claim 1, it is the examiner position that Nishiguchi's polyvinyl alcohol composition inherently possesses these properties. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. *In re Fitzgerald* 619 F 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

With regard to the limitations of claims 8-10 and 13-19, Nishiguchi discloses the usage of ethylene glycol, glycerol or diglycerol as plasticizers, and low-molecular weight polyethylene glycol, coloring agent, release agent, an alkaline substance, agricultural chemical, etc. page 3, [0026-0027]). All of the above compounds can be considered as chemical.

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8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiguchi'096 in view of Nishiguchi et al. (JP 10-060207).

With regard to the limitations of claim 7, Nishiguchi'096 discloses that further the components can be mixed with fine particles (page 3, [0022]), but he does not disclose that polyvinyl alcohol film further contains inorganic filler (B) having an average particle size of 1 to 10 μm .

Nishiguchi'207 discloses a water-soluble film comprises (A) a modified polyvinyl alcohol and (B) preferably 2-20 wt.% (based on the component A) of fine powder such as clay which has $\ll 150 \mu\text{m}$ average particle diameter (abstract). Such class of insoluble or poorly soluble impalpable powder can include clay, kaolin, an aluminum hydroxide, a calcium carbonate, a titanium hydroxide, etc. (page 3, [0025]).

Both references are analogous art because they are from the same field of endeavor concerning water-soluble film compositions comprising polyvinyl alcohol and additional ingredients.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate inorganic fine powder having an average particle diameter less or equal to 150 μm as taught by Nishiguchi'207 into the pressure sensitive adhesive composition of Nishiguchi'096 polyvinyl alcohol film composition because all of such impalpable powder prevent the stickiness accompanying moisture absorption and its effect on film physical properties is suppressed (JP'207, page 3, [0026]), and thus to arrive at the subject matter of claim 7.

Thus, the combination of Nishiguchi'096 and Nishiguchi'207 renders all instant claims *prima facie* obvious in view of absent of unexpected results commensurate in scope of claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Examiner
Art Unit 1713

MB
09/20/2006


LING-SUI CHOI
PRIMARY EXAMINER